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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/919,784	07/31/2001	Jeffrey J. Grainger	020313-000510US	4833
20350 7590 01/31/2007 TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			EXAMINER MOONEYHAM, JANICE A	
			ART UNIT	PAPER NUMBER
			3629	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		01/31/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/919,784

Applicant(s)

GRAINGER ET AL.

Examiner

Janice A. Mooneyham

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 November 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,7-16,18-23 and 25-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1,3,7-16,18-23 and 25-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This is in response to the communication filed on November 7, 2006, wherein:

Claims 1, 3, 7-16, 18-23, and 25-30 are currently pending;

Claims 1, 3, 7, 9, 12, 16, 27-30 have been amended;

Claims 2, 4-6, 17, and 24 have been cancelled.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on November 7, 2006 has been entered.

Information Disclosure Statement

3. The information disclosure statement (IDS) submitted on June 23, 2006 is being considered by the examiner.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 29-30 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

MPEP 2106 states as follows:

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Non-statutory Subject Matter

- Claims to computer-related inventions that are clearly non-statutory fall into the same general categories as non-statutory claims in other arts, namely natural phenomena such as magnetism, and abstract ideas or laws of nature which constitute "descriptive material." □P8□
- Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." □P8□
-
- "Functional descriptive material" consists of data structures and computer programs which impart functionality when encoded on a computer-readable medium. □P8□
- "Nonfunctional descriptive material" includes but is not limited to music, literary works and a compilation or mere arrangement of data. □P8□
- Both types of "descriptive material" are Non-statutory when claimed as descriptive material per se. When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases. □P8□
- When nonfunctional descriptive material is recorded on some computer-readable medium, it is not structurally and functionally interrelated to the medium but is merely carried by the medium. Merely claiming nonfunctional descriptive material stored in a computer-readable medium does not make it statutory. □P8□
-

(a) Functional Descriptive Material: "Data Structures" Representing Descriptive Material Per Se or Computer Programs Representing Computer Listings Per Se□P9□

- Data structures not claimed as embodied in computer-readable media are descriptive material per se and are not statutory because they are neither physical "things" nor statutory processes. Such claimed data structures do not define any structural and functional interrelationships between the data structure and other claimed aspects of the invention which permit the data structure's functionality to be realized. □P9□
- In contrast, a claimed computer-readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the medium which permit the data structure's functionality to be realized, and is thus statutory. □P9□
- Similarly, computer programs claimed as computer listings per se, i.e., the descriptions or expressions of the programs, are not physical "things," nor are they statutory processes, as they are not "acts" being performed. □P9□

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- In contrast, a claimed computer-readable medium encoded with a computer program defines structural and functional interrelationships between the computer program and the medium which permit the computer program's functionality to be realized, and is thus statutory. □P9□
- **Since a computer program is merely a set of instructions capable of being executed by a computer, the computer program itself is not a process** and Office personnel should treat a claim for a computer program, without the computer-readable medium needed to realize the computer program's functionality, as Non-statutory functional descriptive material. □P9□
- When a computer program is claimed in a process where the computer is executing the computer program's instructions, Office personnel should treat the claim as a process claim. □P10□
- When a computer program is recited in conjunction with a physical structure, such as a computer memory, Office personnel should treat the claim as a product claim. □P10□
- **(b) Nonfunctional Descriptive Material**
- Where certain types of descriptive material, such as music, literature, art, photographs and mere arrangements or compilations of facts or data, are merely stored so as to be read or outputted by a computer without creating any functional interrelationship, either as part of the stored data or as part of the computing processes performed by the computer, then such descriptive material alone does not impart functionality either to the data as so structured, or to the computer. Such "descriptive material" is not a process, machine, manufacture or composition of matter. □P10□

Claims 29-30 as written are claiming only instructions. Thus, the claim is not statutory. To render the claim statutory, the applicant may amend to define the invention as:

A computer software program embodied on a computer-readable medium, the computer software program comprising a set of instruction that when executed by a computer cause the computer to perform the steps of:

providing an interface,

receiving, from the user via the interface, a signal

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 3, 7-16, 18-23, 25-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rivette et al (US 2003/0046307) (hereinafter referred to as Rivette) in view of Petruzzi et al (US 6,049,811) (hereinafter referred to as Petruzzi) in view of Tran (US 2001/0049707).

Referring to Claims 1, 16, 18, 22-23 and 27:

Rivette discloses a computer implemented method, system and program, the system comprising a processor, a database in communication with the processor and computer readable medium (Figures 3 (316), 6, 111, 117, and Figure 8(808) and paragraph [0290] and [0407]), the method comprising:

providing, at a client system, a search interface to allow a user to search one or more data sources for potential prior art references [0393] [0396] [0407];

receiving, at the client system, input from a user indicating that the user has identified an electronic document as a prior art reference [1157];

in response to the input, transmitting a signal from the client system indicating that the user has identified a prior art reference [1193];

receiving the signal at a sever system comprising a database [0373-0379];

in response to the signal, accessing the electronic document [0373-0379];
loading into the database at least a portion of the document [0373-0379];
associating in a case table, the reference link with an identifier [0388-0394].

While Rivette discloses searching and storing and retrieving relevant documents to a patent application, Rivette does not disclose using the information in the process of generating an information statement in a form suitable for filing with an official patent office, or transmitting the document to the patent office.

However Petruzzi discloses an electronic information disclosure statement and incorporating, with an automated process, at least some of the extracted information from the electronic document into an electronic information statement wherein the at least one electronic document includes information corresponding to a plurality of fields in the electronic information disclosure statement, and wherein incorporating at least some of the extracted information comprises storing the information in the corresponding plurality of fields in the IDS (Figure 2 (Forms 39) col. 2, lines 65-67 col. 5, line 48 thru col. 6, line 7 The Form 1449 for submitting information in the form of patents, publications, etc is provided, operator is prompted for references, a brief description of each reference and the relevance. After information is inputted, the computer automatically generates a first draft).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate into the searching and storage of relevant documents disclosed in Rivette the electronic IDS taught in Petruzzi so that once the

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relevant documents are identified, the applicant is able to comply with the rules and regulations of the patent office by submitting the relevant prior art as required.

Rivette nor Petruzzi disclose transmitting the electronic information statement to the official patent office.

However, Tran discloses providing for the transmission of the statement to an official patent office (Figure 2C File application, [0007] generation and filing of a complete patent application [0017] techniques support electronic patent filing).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate into the search and retrieval disclosed in Rivette and the electronic IDS disclosed in Petruzzi the transmission taught in Tran so as to provide support for electronic patent filing that substitutes an electronic form of an IDS for a paper copy and to facilitate and enhance the procurement and trading of IP assets.

NOTE: Claim Construction - "Automatically" - Without human interaction such that a human does not have to intercede and alter the flow. Process may be automatic even though human initiates or may interrupt *Collegenet, Inc. v Applyyourself, Inc.* (CAFC, 04-1202,1222-1251, 8/2/2005)

Referring to Claim 3:

Rivette discloses storing a reference link to the electronic document in a reference table and storing an identifier corresponding to a patent case in a case

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number table and associating the reference link in the reference table to the identifier in the case number table [0373-0379].

Referring to Claims 7-8, 19-21:

Rivette discloses providing a prompt comprising an electronic button [0407].

Referring to Claim 9:

Rivette discloses wherein the first data source is coupled to the remote server system over a computer network (Figure 3).

Referring to Claim 10:

Tran discloses providing access to the electronic IDS to multiple users over a network ([Figure 1 and [0043] one or more client workstations are connected).

Referring to Claim 11:

Tran discloses electronically transmitting the electronic IDS to a patent office (Figure 2C file application, [0007] generation and filing of a complete patent application [0017] techniques support electronic patent filing).

Referring to Claim 12:

Tran discloses receiving at the server system a signal indicating that a patent application corresponding to the electronic IDS is being electronically transmitted to a patent office ([0017] [0048] [0049]).

Referring to Claims 13-15:

Rivette discloses wherein the electronic document is an electronic version of a US patent, a foreign patent or a publication ([0321-0322]).

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Response to Arguments

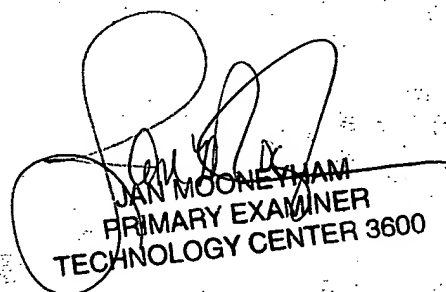
Applicant's arguments with respect to claims 1, 3, 7-16, 18-23 and 25-30 have been considered but are moot in view of the new ground(s) of rejection.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janice A. Mooneyham whose telephone number is (571) 272-6805. The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


JAN MOONEYHAM
PRIMARY EXAMINER
TECHNOLOGY CENTER 3600